

REMARKS

This is a response to the Office Action mailed on May 7, 2004.

Claims 1-8, 10, 11 and 15-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent 6,513,160 to Dureau in view of U.S. patent 6,184,937 to Williams. Applicants respectfully traverse the rejections for at least the following reasons.

Dureau describes a system for promoting viewer interaction by providing a genie that encourages the viewer to participate in contests, advertisement, promotions and the like. The genie appears to be healthy and smiling or unhealthy and frowning depending on the time the viewer spends watching an associated program and/or the interactivity of the viewer with the program (col. 6, lines 40-45 and 52-56). To achieve this, an interactive application is time-multiplexed with the television program and transmitted to a set-top box (col. 2, lines 63-67).

Regarding claim 1, the Examiner acknowledges (Office Action, p. 3) that Dureau fails to disclose controlling an animated character based on a determination that a first predetermined event comprising at least one of an audio and video event in the program being watched has occurred. However, the Examiner asserts that it would be obvious to modify Dureau's system with Williams's technique of having an animated character that responds or reacts to some predetermined audio event from a broadcast program. Applicants respectfully disagree with this assertion.

First of all, in contrast to Applicants' invention, Williams is not concerned with generating an animated character on a portion of a display as an animated viewing companion, where the animated viewing companion is provided on a display while a viewer is watching a

program. Thus, with Applicants' invention, the animated character is distinct from the program being viewed. In contrast, Williams states:

"Making an inserted indicia appear as if it is actually part of the original video scene is an important aspect of the technology." (col. 2, lines 30-32).
and

"Insertion processor 46 (FIG. 1) takes key 32 and a logo image 26 and places logo image 26 into the live video 28 so that logo image 28 looks as if it is part of the original scene." (col. 3, lines 65-67).

For example, with the Williams approach, an animated team mascot can be inserted into a stadium to create the illusion that the mascot is actually in the stadium and encouraging the fans to cheer (col. 2, lines 45-52). Such an animated character is therefore part of a program being watched, and not an animated viewing companion.

Accordingly, the combination of Dureau and Williams, if made, *arguendo*, would only result in a system where Dureau's genie character is inserted into a video program as part of the original video scene. Moreover, Applicants submit that it would not be obvious to modify Dureau as asserted by the Examiner. Generally, to establish *prima facie* obviousness, there must be some suggestion or motivation to modify a reference. *See, In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment."

Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The Examiner asserts that it would be obvious to modify Dureau's system with Williams's technique of having an animated character that responds or reacts to some predetermined audio event from a broadcast program, and that the motivation for doing so is to provide an interesting and interactive character appear as if it was part of an original video scene, and because it is an important aspect of the Williams video technology. However, Dureau states

that its genie character is intended to "increase the likelihood that viewers in the targeted demographic groups will watch television programs and/or advertisements and participate in associated promotions" (col. 2, lines 56-59), and that the genie is "associated with a particular channel or program" (col. 2, line 30). Clearly, there is no intention of having the genie become part of the original video program. Thus, Dureau only teaches away from the combination suggested by the Examiner. Williams is concerned with the opposite case of having an animated character appear as part of a program being watched. A person of ordinary skill in the art would therefore not be led to combine these disparate and conflicting concepts.

Accordingly, Applicants' claim 1 and the analogous claim 10 are believed to distinguish over the cited references, and withdrawal of the rejection is respectfully requested. Moreover, the dependent claims of claims 1 and 10 are believed to recite further patentable features

Regarding dependent claims 12 and 13, the Examiner takes Official Notice that it would be obvious to modify William's teachings to synchronize an animal character with a corresponding broadcast program. Applicants respectfully traverse the Official Notice and kindly request the Examiner to provide a reference supporting such Official Notice.

Independent claim 15 sets forth controlling an animated character based on a comparison between a selected program and a stored profile of previously made program selections. In contrast, Dureau only looks at a data file of viewing information to determine an elapsed time since a given program was last viewed (column 6, lines 56-65). Dureau compares the current date with the last viewing date of an "associated program or channel", and then compares the elapsed time with a predetermined value or range of values, e.g., to adjust a health of the genie (col. 6, line 52 to col. 7, line 5). However, this does not involve making a comparison between a selected program and a stored profile of previously made program selections as claimed by

Applicants. Instead, as mentioned, the genie is already associated with a particular program or channel, so the only determination that is needed for controlling the genie is the last time that the particular program or channel was viewed. For example, Dureau states at col. 7, lines 6-7:

“The interactive application is associated with a particular television program and is intended to increase the viewership of that program.”

In contrast, Applicants' approach is more sophisticated in that comparisons between a selected program and a viewing history of different programs is made, and the animated character is controlled in response to this comparison.

Claim 15 and the dependent claims thereof are also therefore believed to be allowable over the cited references. For example, claim 17 sets forth determining a degree of consistency between a selected program and a stored profile, and generating one of a plurality of approval responses depending on the degree of consistency. Dureau fails to disclose or suggest this feature. As mentioned, Dureau only determines whether the viewer is watching the particular program or channel that is associated with the genie, and does not compare a selected program with a stored profile, much less determine a degree of consistency between a selected program and a stored profile. Regarding the passages cited by the Examiner, col. 6, line 52 to col. 7, line 5 of Dureau refers to adjusting the health of the genie based on the elapsed time since an associated program or channel was last viewed, col. 7, lines 35-43 refers to setting a health index of the genie based on the amount of time the viewer spends watching the associated television program, or providing the genie with “special powers” based on viewer interactions with advertising promotions, and col. 8, lines 1-28 refers to adjusting the health of the genie based on the elapsed time since an associated program or channel was last viewed, or based on required inputs from the viewer, such as button presses. These passages therefore do not relate to

determining a degree of consistency between a selected program and a stored profile as claimed by Applicants. Withdrawal of the rejection is therefore respectfully requested.

Claims 9, 14 and 20-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Dureau in view of Williams and U.S. patent 5,393,073 to Best.

Best discloses a talking video game showing animated characters that simulate a voice dialog with the viewer. As the game is played, the characters talk to the human viewer and wait for a response via a hand-held controller. Based on the viewer's selection, the scene branches to a corresponding scene. (Abstract). However, Applicants' claims 9 and 14 set forth that an animated character is controlled so that it responds to an audio and/or video event in a program being watched by turning the animated character so that its face faces the viewer. Thus, the animated character exists apart from the program being watched and is not simply a component of a video game or cartoon. The Best video game is not concerned at all with an animated character that responds in this manner. Nor is Best concerned with, or relevant to, an animated viewing companion. Applicants therefore respectfully submit that there is no motivation to combine the references as suggested, and even if such a combination were attempted, it still would not result in a method that discloses or suggests the claimed invention. Only with the hindsight of Applicants' invention would such a combination be proposed.

Regarding claims 20 and 22, Applicants do not see how Best or the other cited references relate at all to an animated character that is generated as an animated viewing companion with the claimed features. The fact that Best shows different animations is not relevant at all to Applicants' invention as claimed. Claims 20 and 22 set forth that an animated character is controlled to transition from a normal TV-watching animation to one of a plurality of other animations. The Examiner is respectfully requested to point out where the cited references show

an animated character that is generated as an animated viewing companion that is provided in a normal TV-watching animation, e.g., where the animated character appears to be watching the same program as the viewer. See Applicants' specification, state S1 in Fig. 4, and page 15, lines 6-10.

Withdrawal of the rejection is therefore respectfully requested.

In view of the above, each of the currently pending claims is believed to be in condition for allowance. The Examiner is respectfully requested to pass this application along to an early issue. The Examiner is invited to telephone the undersigned if there are any further issues to address.

Respectfully submitted,

Ralph F. Hoppin
Ralph F. Hoppin
Registration No. 38,494

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

RH/rjl